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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/471,669

12/24/1999

JOHN P. ANDERSON

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06/26/2006

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EXAMINER

WALICKA, MALGORZATA A

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 06/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/471,669

Applicant(s)

ANDERSON ET AL.

Examiner

Malgorzata A. Walicka

Art Unit

1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Jun. 5, 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see the attached.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☒ Other: signed 1449 forms of IDSs:

09/01/05, 03/15/05, 02/18/05, 02/16/05, 01/12/05, 12/08/04, 11/23/04.

Continuation of 3. NOTE: amendment to claim 130 makes it a duplicate of claim 48.

ADVISORY ACTION

Amendment under 37 CFR 1.116 filed June 5, 2006 is acknowledged. Claims 1-47 have been withdrawn. Claims 48-50, and 70-113 have been previously canceled; claims 63, 183, 189, 195, 201, 207, 213, 219 and 225 have been currently cancelled. Claims 48, 58, 64, 114, 122, 130, 138, 146, 154, 162, 170, 178, 184, 190, 196, 202, 208, 214, 220, 240, 259, 278, 297, 316, 335, 354, 373 have been amended, and claims 316-391 have been also amended due to renumbering of the claims after claim 312. Claims after claim 312 had wrong numbering due to typographical error of duplication numbers 311 and 312 in numbering of the claims. Claims 1-48, 51-62, 64-69, 114-182, 184-188, 190-194, 196-200, 202-206, 208-212, 214-218, 220-224 and 226-391 are pending. Claims 1-47 are withdrawn as directed to a non-elected invention.

The Amendment filed June 5, 2006 raises new issues as previously indicated, and has not overcome outstanding rejection of claims 48, 51-57, 130-137, 138-145 and 154-161 under 35 USC 102 as of June 16, 2006, i.e., the end of six months period for response to the Final rejection of Dec. 16, 2005. Applicants did not filed Notice of Appeal as of June 16, 2006, the amendment to the claims is not entered and the case will be abandoned.

If the amendment to the claims were entered the examiner would have withdrawn rejection of claims under 35, the rejection of claims 114-121, 122-129, 146-153 and 162-177 under 35 USC 102, and USC 112, second and first paragraph, but would not

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have withdrawn rejection of the remaining claims under 35 USC 102 for the reasons explained bellow. This Advisory Notice uses current corrected numbering of the claims.

As to other formal matters, the examiner attaches signed forms 1449 of 09/01/05, 03/15/05, 02/18/05, 02/06/05, 01/12/05, 12/08/04 and 11/23/04 which do not appear in the records available to the examiner as being signed.

35 U.S.C. 112, second paragraph

If the amendment to the claims were entered the following withdrawal of rejection would be proper.

Claim 48, 114, 122, 130, 138, 146, 154, 162 and 170, were finally rejected under 35 U.S.C. 112, second paragraph, as being still confusing. Dependent claims 51-57, 115-121, 123-129, 131-137, 139-145, 147-153, 155-161, 163-169, 171-177 were included in the rejection, because they did not correct the language of the claims from which they depend.

Rejection of claims 48, 51-57 and 114-177 is withdrawn, because the claims have been amended.

Furthermore, claims 58-69,
claims 178-183 and 240-258,
claims 184-189 and 259-277,
claims 190-195 and 278-296,

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claims 196-201 and 297-315,

claims 202-207 and 316-334,

claims 208-213 and 335-353,

claims 214-219 and 354-372, and

claims 220-224 and 373-391 were rejected because the base claims 58, 178, 184, 190, 196, 202, 208, 214, 220 were confusing. Rejection of claims 58-62, 64-69, 178-182 and 240-258, 184-188 and 259-277, 190-194 and 278-296, 196-200 and 297-315, 202-206 and 316-334, 208-212 and 335-353, 214-218 and 354-372, 220-224 and 373-391 is withdrawn because the claims have been amended. Rejection of claims 63, 183, 189, 195, 201, 207, 213, 219, 225 is moot because the claims have been cancelled.

35 USC, first paragraph

If the amendment to the claims were entered the following withdrawal of rejection would be proper.

Claim 63, 183, 189, 195, 201, 207, 213, 219 and 225 were rejected under 35 U.S.C. 112, for the reasons explained in the previous Office Actions.

This rejection is now moot because claims 63, 183, 189, 195, 201, 207, 213, 219 and 225 have been cancelled.

35 U.S.C. 102

If the amendment to the claims were entered the following withdrawal of rejection would be proper.

Claims 48 and 51-57, claims 114-121, claims 122-129, claims 130-137, claims 138-145, claims 146-153, claims 154-161, claims 162-169 and claims 170-177 were rejected in the previous action for the reasons explained in the Office Actions of March 1, 2005, and December 16, 2005, as anticipated by the US Patent 6, 420,534 issued to Gurney et al., with priority to the provisional application 60/101,594 ('594) filed Sept. 24, 1998. The amendments to the claims do not overcome the 102 rejection of claims 48, 51-57, 139-137, 138-145 and 154-161 which recite

SEQ ID NO:43 (amino acids 46-501)

SEQ ID NO: 67 (amino acids 58-501)

SEQ ID NO: 69 (amino acids 63-501)

because **it is an inherent feature** of SEQ ID NO:1 (SEQ ID NO:5 in Gurney) that expression thereof in heterologous cells **produces** a protein consisting of **amino acids 22-501, 46-501, 58-501 and 63-501 of SEQ ID NO:2**, even if Gurney has not disclosed it. On the other hand, **the polypeptides having truncated C-terminus**, i.e.,

SEQ ID NO: 58 (amino acids 46-452)

SEQ ID NO: 59 (amino acids 1-452)

SEQ ID NO: 60 (amino acids 1-420)

SEQ ID NO: 68(amino acids 58-452)

SEQ ID NO: 70 (amino acids 63-452)

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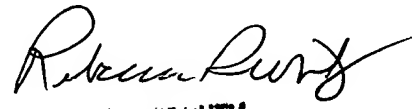
SEQ ID NO: 74 (amino acids 22-452)

are not inherently expressed from SEQ ID NO:1 of the instant application or SEQ ID NO: 5 of Gurney. For that reasons the 102 rejection of claims 114-121, 122-129, 146-153 and 162-177 is withdrawn.

The examiner suggests amending the claims accordingly, and invites the Applicants to discuss any outstanding issue in a telephonic interview.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Malgorzata A. Walicka whose telephone number is (571) 272-0944. The examiner can normally be reached on Monday-Friday from 10:00 a.m. to 4:30 p.m.

Malgorzata A. Walicka, Ph.D.
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Patent Examiner


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